

**REMARKS**

In the last Office Action, the Examiner objected to the drawings for lack of compliance with 37 CFR § 1.121(d). The Examiner rejected claims 7-12 under 35 U.S.C. §101 as being drawn to non-statutory subject matter. In addition, the Examiner rejected claims 7-12 under 35 U.S.C. §103 as being unpatentable over Fortin (WIPO Publication 2000/72768 A1) in view of Zacouto et al. (U.S. Publication 2002/0151978).

By this amendment, Applicants cancel claims 7-12 and add new claims 13-22. The originally filed specification and drawings fully support new claims 13-22. Accordingly, no new matter has been introduced by this reply.

Applicants traverse the Examiner's rejections and respectfully request reconsideration for at least the reasons set forth below.

**Objections to the Drawings**

The drawings stand objected to under 37 C.F.R. § 1.21(d). The Examiner contends only Figs. 1 and 2 were submitted, while the disclosure refers to Figs. 1-11. Thus, the Examiner asserts that the drawings do not contain the full subject matter disclosed in the application. In response, Applicants submit herewith seven New Sheets, which include the missing Figs. 3-11. No new matter has been added. Figs. 3-11 of international application no. PCT/FR2003/002435, of which the present application is a U.S. National Stage Application filed under 35 U.S.C. § 371, fully support Figs. 3-11 in the New Sheets submitted herewith. See WO 2004/016185 A3. It appears Figs. 3-11 were inadvertently omitted from the present application when a preliminary amendment filed March 3, 2006, making correction to Figs. 1, 2A, and 2B was entered.

The Examiner further objects to the drawings, contending that the drawings contain parts which are drawn by hand and, thus, not as clear as applicant is capable of providing. The drawings have been amended to replace all hand-drawn portions with professionally drafted substitutes.

Finally, the Examiner objects to the drawings because the specification refers to numbers that are not shown in the drawings. The amendments to the specification included above correct all references to numbers not shown in the drawings. No new matter has been added. The amendments to the specification are fully supported by the original drawings.

Withdrawal of the objections to the drawings, and approval of the replacement and new drawings by the Examiner is respectfully requested.

#### **Claim Rejections**

##### **§ 101 Rejections**

Claims 7-12 stand rejected under 35 U.S.C. § 101 for allegedly being drawn to non-statutory subject matter by positively reciting part of a human. Claims 7-12 have been canceled, and the rejections under 35 U.S.C. § 101 of these claims are therefore moot.

##### **§ 103 Rejections**

Claims 7-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fortin in view of Zacouto et al. The Examiner alleges that Fortin discloses each of the elements of the claims except a cushioning device as part of a distraction device. The Examiner further alleges that Zacouto et al. teaches a distraction and cushioning device, and that it would have been obvious to one of ordinary skill in the art at the time

the invention was made to modify the distraction device of Fortin, to add a cushioning device to the end of at least one toothed rod, as taught by Zacouto et al.

Claims 7-12 have been canceled, and the rejections under 35 U.S.C. § 103 of these claims are therefore moot. Furthermore, new claims 13-22 are not obvious over Fortin in view of Zacouto et al. because the references, even when combined, do not disclose, teach, or suggest all of the claimed elements/limitations.

Not all elements of claim 13 are taught by Zacouto et al. at least because Zacouto et al. fails to teach a damping member having a first end coupled to an end of a rod member and a second end configured to be coupled to a bone structure. Claim 13 requires "a first damping member, having a first end coupled to the first end of the first rod member and a second end configured to be coupled to a first bone structure." However, Zacouto et al. only teaches a damping member that is coupled to an end of each of two rods, such that the damping member is between the two rods. As Zacouto et al. states at col. 19, ll. 35-37, "[a]ccording to the invention, the opposite ends of the [rods] 7 and 8 are connected by a shock-absorbing device[,]" the cushioning device of Fig. 1a, which the Examiner points to as the cushioning device taught by Zacouto et al. Nowhere does Zacouto et al., nor Fortin, teach a damping member, having a first end coupled to an end of a rod member and a second end configured to be coupled to a bone structure. For at least this reason, the references, even when combined, do not disclose, teach, or suggest all of the claimed elements/limitations of independent claim 13. Thus, independent claim 13 and claims 14-22, which depend from claim 13, are not obvious over Fortin in view of Zacouto et al.

Moreover, all elements of claim 14 are not taught by Zacouto et al. at least because Zacouto et al. fails to teach a damping member comprising a first and a second elastic member disposed within a rigid cylinder. While Zacouto et al. teaches several variations of damping members, each utilizes control of viscous fluid within chambers to accomplish damping. In contrast, claim 14 claims a damping member that "comprises: a rigid cylinder; a first elastic member disposed within the rigid cylinder; and a second elastic member disposed within the rigid cylinder[.]"

Furthermore, modifying the damping members of Zacouto et al. to instead utilize the structure of the damping device of claim 14 would not have been obvious to one of ordinary skill in the art, because such a modification would render inoperable an essential aspect of the Zacouto et al. invention--providing damping with a resistance that can be adjusted after implantation of the device in a patient. As Zacouto et al. states, "no prosthesis with a functional characteristic of viscous resistance has yet been proposed wherein the coefficient of resistance would be adjustable. This combination is essential in the primary function of the invention[.]" Zacouto et al. at col. 3, ll. 14-17. However, hypothetically modifying the damping members of Zacouto et al. to instead simply comprise a first and a second elastic member disposed within a rigid cylinder would not provide an adjustable coefficient of resistance. In Zacouto et al., it is adjustment of communication and flow of the viscous fluid within chambers that permits adjustment of the damping resistance. Thus, modifying the damping members disclosed in Zacouto et al. to take the form claimed in claim 14 would not have been obvious to one of ordinary skill in the art. For at least this reason, claim 14 is not obvious over Fortin in view of Zacouto et al.

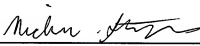
In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 20, 2009

By:   
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Nicholas S. Stroeher  
Reg. No. 62,926  
(617) 617-1647

**Attachments:**

Replacement Drawing Sheets (Figs. 1-2B)  
New Drawing Sheets (Figs. 3-11)